REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-22 are now present in this application. Claims 1, 11 and 12 are independent.

Reconsideration of this application is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent Application Publication 2003/0074672). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.

Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof, it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the *Administrative Procedure Act*, 5 U.S.C. § 706(A), (E) (1994). See *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. See *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. See *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Daniels does not disclose or suggest the features positively recited in claims 1-22. Claim 1, for example, positively recites a combination of features, including separating AV broadcast signals and data broadcast signals from digital television broadcast signals of at least one channel; selectively mixing the AV broadcast signals and the data broadcast signals according to a display setup request inputted by an input unit; providing the selectively mixed signals directly to a first display unit; and providing the selectively mixed signals via a home network to at least one display unit other than the first display unit and other than the input unit. Independent claims 11 and 12 include similar features in a varying scope.

Daniels' discussion of a home network is in terms of using a wireless display terminal as a

portable digital assistant when it is in range of its "home" multimedia network – see paragraph [0030], for example. Daniels does not explicitly, or inherently (i.e., not just possibly and not just probably, but necessarily) disclose providing the selectively mixed signals directly to a first display and providing the selectively mixed signals via a home network to at least one display unit other than the first display unit and other than the input unit that provides a display setup request, as recited.

Moreover, the reliance of the rejection on seven different paragraphs of Daniels to somehow disclose this claimed combination of features overlooks the fact that Daniels contains no concept of displaying the same selectively mixed signals directly to the first display and also to a second display other than the first display or the input unit, and via a home network.

Moreover, with respect to claims 4, 7 and 18, just because multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) does this, and that is what is required to anticipate the claims.

Furthermore, with respect to claims 5, 8, 9, 17 and 19, just because multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) does this, and that is what is required to anticipate the claims.

Similarly, with respect to claim 6, just because multiple displays are "capable of" displaying

video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) does this, and that is what is required to anticipate the claims.

Also, with respect to claim 16, just because multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) does this, and that is what is required to anticipate the claims.

For at least these reasons, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Daniels.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-22 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

EHC/RJW:tm

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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